

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the Office Action dated December 20, 2006. In order to amend the claims and present an additional 1.131 Declaration, Applicants have filed a Request for Continued Examination. Applicants remain of the position that patentable subject matter is present and, therefore, Applicants respectfully reconsideration of the Examiner's position based on the amendments to the claims, the 1.131 Declaration and the following remarks.

Claims Status

Claims 1, 3, 5-11 and 13-19 are pending in this Application. Claims 18 and 19 have been amended herein. Specifically, Claim 19 has been amended to change "inorganic particles" to "hydrophobic silica particles". Claim 19 has been amended to be consistent with the wording in Claim 5, namely, that the layer contains hydrophobic silica particles. With respect to Claim 18, Claim 18 has been amended herein to more particularly point out the claimed invention and to address the Examiner's comments as contained in the Office Action. It is believed that Claim 18 now makes it clear that the same

developer is used for each of the images and the developer and the photoreceptor meets the limitations as recited in Claim 1.

Respectfully, no new matter is added by way of these amendments.

112 Rejection

Claims 18 and 19 are rejected under 35 USC 112, second paragraph, as being indefinite.

It is respectfully submitted that the amendments made to Claims 18 and 19 make each of these claims definite.

Prior Art Rejection

The Examiner had put forward four Prior Art rejections, namely:

- (1) Claims 1, 5-9, 13-15, 18 and 19 had been rejected as being unpatentable over Asano in combination with Uchida;
- (2) Claim 10 had been rejected as being unpatentable over a combination of Asano and Uchida;
- (3) Claims 3, 16 and 17 had been rejected as being unpatentable over a combination of Asano, Uchida and Hagi; and

- (4) Claim 11 had been rejected as being unpatentable over a combination of Asano, Uchida and JP '417.

As the Examiner will recall, Asano has a U.S. filing date of February 28, 2003 and Applicants had previously submitted a Declaration to attest to the fact that Applicants had made their Invention in Japan at least as early as December 24, 2002. Specifically, Applicants have submitted a copy of their Japanese Application as published and an English Translation of the Japanese Application, all of which was submitted in January 2006. The Examiner had raised a number of issues with respect to the previously submitted Declarations and those issues will be addressed in turn.

First, the Examiner stated that the Declaration does not state that the Invention was made in a WTO or NAFTA country. The Examiner's attention is directed to Paragraph 3 of the Declaration filed in January 2006 which states that the Inventors invented the Invention claimed in this Application in Japan. In Rule 131(b), it states that the evidence should prove a reduction to practice prior to the effective date of the reference. The Examiner's attention is also directed to Paragraph 3 of the attached Declaration which states that they reduced to practice the Invention in Japan.

Respectfully, Applicants made the necessary statements that reduction has occurred in a WTO member country, recognizing Japan as a WTO member country.

Second, the Examiner criticized the previous Declarations for failing to explain the absence of any original exhibits or drawings or records of photocopies thereof. In paragraph 4 of the Declaration, the Inventors have explained that original documentation, such as, notebook test results, sketches and drawings or photocopies thereof are not currently available even after a diligent search. The Inventors go on to state that they believe that the best evidence of their Invention is, in fact, the Japanese Application because Japan is the first to file country not a first to invent. Respectfully, the absence of such notebooks, test results, sketches and drawings have been explained in that such is not available and has not been found after a diligent search.

The Examiner will note Paragraph 10 of the Declaration wherein the support for the various claim limitations has been cross-referenced to the Japanese Published Application. The Examiner will also note that the Inventors attest to the fact that the tests and Examples that are reported in the Japanese Application were actually performed by them or under their

direct supervision and control at least as early as December 24, 2002. Furthermore, the Examiner will note Paragraph 11 which states that the machine shown in Figures 1 and 2 was used to perform the tests that are summarized in Table 3, Paragraph 87, and the results as reported in Table 4 on Paragraph 96 of the Japanese Application.

Respectfully, it is submitted that the claim limitations are satisfied by the examples and that the amount of evidence provided clearly surpasses unsupported proof.

In fact, the Examiner's attention is directed to MPEP 715.07 which points out that evidence of the prior invention can be provided by disclosure documents, see Paragraph (H) on page 700-281. Respectfully, the Patent Office recognizes that such documents like disclosure documents or, for that matter, patent applications, clearly are of a weight to support the Invention.

In fact, the Examiner will note that for purposes of "priority", the evidence afforded a prior filed patent application is given sufficient weight to prove a date of invention. The Examiner will recognize that in Interference practices, Priority Documents are taken for purposes of proving dates of invention. Under 35 USC 119, foreign priority

documents are deemed by the Court to be sufficient to establish dates of reduction to practice as to foreign filing dates. It is submitted that there is no difference between the evidentiary weight provided to a foreign filing document and the evidentiary weight that should be provided under a 1.131 Declaration. In other words, if a foreign filing document is sufficient under 35 USC 119, the same document should be sufficient under Rule 131 Declaration. In fact, it is submitted that U.S. case law supports such a conclusion, see *In re Mulder*, 716 Fed. 2nd 1542 219 U.S.P.Q. 189 (Fed. Circ. 1983).

Respectfully, Applicants submit that they have provided enough factual evidence to support their claim of prior invention and to remove Asano as a Prior Art reference.

One Month Extension of Time

Applicants hereby request a one month extension of time within which to file the Request for Continued Examination in this case and submit herewith the fee associated therewith.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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Encl: Executed 1.131 Declaration